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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/660,337
Filing Date: September 11, 2003
Appellant(s): ERNEST ET AL.

Darcell Walker
Reg. No. 34,945
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 24, 2009 appealing from the Office action mailed August 14, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

35 USC §102(e) of claims 1-4, 7, and 15-20 as anticipated by Malik (7,003,551).

35 USC §103(a) of claims 8, 10, 12-14, and 21-27 as unpatentable over Malik in view of Dunn (2004/0034688).

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7-8, 10, and 12-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1:

The claim comprises each of “an attachment document, the attachment, and the attachment docket, it is not clear from the claim whether each of these items are the same thing, or if they are intended to be different entities.

The claim comprises the limitation “receiving an electronic mail message at a destination location” in line 3, then goes on to recite “the electronic mail message received at the sender location” in line 11. It is not clear from what is being implied by having the mail message received at the destination and at the sender.

The claim comprises the limitation “the original document” there is no antecedent basis for the original document.

The claim recites both “*when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message, deleting the attachment document from the electronic mail message received at the sender location of the electronic mail message originated at the destination location of the electronic message*” and “*deleting the attachment document when the determination is that the attachment docket was originally created at the location of the sender of the electronic mail message updating the received message to reflect the deleted attachment.*” Those limitation appear to be the same concept only worded differently, it is unclear if the steps are performed twice or if they perform a slightly different function.

The claim recites “*creating a link to the original document located at the destination location of the electronic message.*” It is not clear from this limitation what the original document is, or if the original document what based on what the sender was attaching to the email why that document is located at the destination, not at the sender.

The claim recites “determining whether there is an attachment document associated with the received electronic mail message; when the determination is that there is an attachment document, determining an the origin of the an attachment to the electronic message, by determining whether the attachment was created at the location of the sender of the electronic message.” The use of commas in this limitation suggests that the “by determining...” limitation is modifying the determination of whether there is an attachment, not the step of determining the origin of the attachment document.

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Regarding claim 2:

The claim recites the idea that the destination location is the sender location. It is unclear how or why the sender location is also the receiving location unless all the mail messages are only being sent to themselves.

Regarding claim 3:

The claim appears to need some punctuation to convey the idea that the step of determining if there is an attachment occurs before the origin determination.

The limitation of determining if the email contains an attachment has been amended into the independent claim, there appears to be a lack of antecedent basis now in claim 3.

Regarding claim 7:

There is a lack of antecedent basis for “the recipient.”

The claim recites the limitation “the step of determining whether the recipient of an electronic message desires to save the electronic message,” the idea of the computer determining a user’s desires is very ambiguous, there seems to be a separation between an action that the user of a computer indicates through a GUI prompt for example and what a user “desires.” The word “desires” also appears in claims 8, 14, 21, and 27, and suffers from the same ambiguity in each claim.

Regarding claim 8:

The claim recites the idea that the attachment document was received in an email message, but the attachment was locally created at the destination location. It is

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unclear from the claim how the attachment can be both received and also locally created.

Claim 8 contains most of the same issues noted in the 112 rejection to claims 1 and 7.

Regarding claims 10, 12, and 14:

The claims recite the limitation “said origin determination,” but the origin determination step has been cancelled from claim 8.

Regarding claim 13:

The claim recites the limitation “the modified attachment.” There is no antecedent basis for this limitation; no limitations indicate an attachment actually gets modified.

Regarding claim 18:

The limitation added in claim 18 appears to be already present in claim 15, thus duplicate.

Claims 15-27 further comprise the same clarity issues as noted in claims 1-4, 7-8, 10, and 12-14 and appropriate action is required.

(10) Response to Argument

Response to argument 7a:

The examiner considered the appellant’s arguments and found them persuasive, thereby the 35 USC §102(e) of claims 1-4, 7, and 15-20 as anticipated by Malik (7,003,551) is **withdrawn**.

Response to argument 7b:

The examiner considered the appellant's arguments and found them persuasive, thereby the 35 USC §103(a) of claims 8, 10, 12-14, and 21-27 as unpatentable over Malik in view of Dunn (2004/0034688) is **withdrawn**.

Response to argument 7c:

The appellant indicates that the 35 USC §112 2nd ¶ were attempted to be addressed in an after final amendment, but that amendment was not entered onto the record. See Appellant's brief, filed July 23, 2009, pg 6.

The examiner agrees, with the status of the claims; the after-final amendment filed December 8, 2008 was not entered. See Advisory filed December 16, 2008. As result the issues addressed in the 35 USC §112 2nd ¶ rejection still persist, thus the rejection is still proper. In fact, the appellant has provided no arguments against the properness of the rejection and based on the pervious attempts to correct the claim language, the appellant seems to indicate that the rejection is in fact a valid one. See Appellant's brief, filed July 23, 2009, pg 6. Since the appellant has not traversed the ¶112 2nd ¶ rejections, they are deemed proper and are maintained.

The examiner would further like to note that the issues addressed in §112 rejection address the ambiguity of the claimed invention and it is unlikely that the amendments proposed in the after-final on December 8, 2008 would have overcome each of the §112 2nd ¶ issues.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/KEVIN BATES/

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